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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : HUBBELL ,et al.
SERIAL NO. : 09/938,286
FILED : August 23, 2001
FOR : Novel Polymer Compounds

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Attention: Response to Restriction Requirement

SIR:

Election of Invention in Response to Restriction Requirement

In response to the Examiner's office action dated October 3, 2003 in the above-referenced patent application, Applicant elects to prosecute a chemical species in which the polyanionic polymer is a carbomer polymer (i.e., a polyacrylic acid based polymer) and the linking moiety is obtained by the reaction of an allyl ether of pentaerythritol or sucrose with said polyanionic polymer or with monomers which form said polyanionic polymer. Claims 1, 2 and 3 are readable on the elected species.

Notwithstanding Applicants' election, Applicants respectfully submit that this species is unduly restrictive and for purposes of administrative efficiency should also include a species wherein the linking moiety is also obtained by the reaction of an acrylate of pentaerythritol (e.g., pentaerythritol triacrylate) with the polyanionic polymer or with monomers which form the polyanionic polymer. Support for the elected species can be found in the specification at page 4, in the first full paragraph. It is respectfully submitted that Applicants' selected species group is sufficiently narrow to allow appropriate examination of the instant application.

Applicants respectfully submit that the suggested species group election would not be so broad as to unnecessarily burden the Examiner in examining the instant application. Applicants respectfully request that the Examiner give careful consideration to examining the suggested species group in determining the appropriateness of this restriction. Applicants further respectfully submit that it is not cogent to suggest that limiting the examined invention to the

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restricted species is necessary given that the broader suggested species group would be easily searched and examined.

Notwithstanding Applicants' election, Applicants respectfully traverse the Examiner's requirement for restriction. Applicants respectfully request reconsideration of the Examiner's requirement for election. Applicants respectfully submit that prosecution of all of the originally filed claims should not be restricted to the elected species group. It is respectfully submitted that the pending claims are directed to pre-formed hydrolytically susceptible polyanionic polymers or methods of making such polymeric compositions which comprise the claimed elements as set forth in claim 1 and the subject matter covered by the claims can readily be examined.

According to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a serious burden would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of the originally filed claims would not place such a serious burden on the Examiner as to require restriction.

Although the claimed compositions and methods which are used in the present methods are generally patentably distinct from each other, Applicants respectfully submit that any search the Examiner would need to conduct in examining the instant application set forth in original claims 1-12 would not be unduly burdensome. Moreover, the examination of these claims would not place such a serious burden on the Examiner as to require restriction.

Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicant wishes the Patent Office to examine his or her application with a certain degree of "judicial efficiency" and wishes to have patent claims issue which reflect the breadth of his or her invention. The balance that is to be weighed should be tipped in this instance by the fact that the claimed methods set forth in claims 1-12 are sufficiently narrow to weigh on the side of examining all the claims indicated above, especially in light of the conceptual limitations of the claimed polymers.

Applicants respectfully submit that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in M.P.E.P. §803. Consequently, Applicant respectfully requests that the Examiner examine all of the claims in the present application, namely claims 1-12.

No fee is believed due for the submission of this response. A revocation of power of attorney and appointment of substitute counsel paper along with an attached assignment document is also enclosed.

Respectfully submitted,

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By: 

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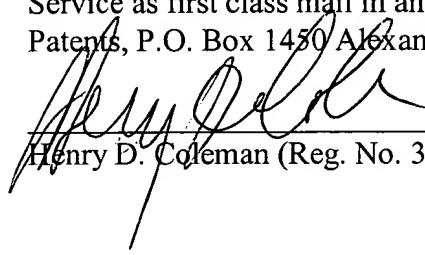
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Dated: October 24, 2003

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450 Alexandria, Virginia 22313-1450 on October 24, 2003.


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